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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/813,706 | 03/21/2001 | Jheroen P. Dorenbosch | PN01003AA | 3438 |

20280 7590 03/17/2005

MOTOROLA INC
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EXAMINER

BILGRAMI, ASGHAR H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,706

Applicant(s)

DORENBOSCH ET AL.

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>07/30/02</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 9, 10 & 17 are rejected under 35 U.S.C. 102(e) as being unpatentable over Voit et al (U.S. 6,185,204).

As per claims 1, 4, 9, 10 & 17 Voit disclosed a method of supporting Internet Protocol (IP) based services initiated through a public network, the services directed to a mobile device through a private network, the method including the steps of: assigning a long lived IP address and a user name to the mobile device in a wireless network; the long lived address mapping the mobile device to a zone of the private network (col.10, lines 45-67); providing a server having an IP address within said zone and including a database having a cross reference between said user name and said long lived IP address for said mobile station; connecting an address space of said zone to the public network using a network address translator (NAT) (col.4, lines 24-37, col.6, lines 19-42); initiating a push session between a push client and the mobile device by forwarding from said push client to said server said user name; retrieving and returning to said NAT said long lived IP address corresponding to said user name; and assigning a dynamic public address

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that corresponds to said long lived IP address, thus the mobile device, using an application level gateway that is associated with said NAT and returning said dynamic public address to said push client (col.13, lines 1-36).

3. As per claims 2 & 11 Voit disclosed the method of claim 1 wherein said step of assigning a long lived IP address further includes including said long lived IP address in a home location register database within a radio network (col.10, lines 45-67).

4. As per claims 3 & 12 Voit disclosed the method of claim 1 wherein said step of assigning a long lived IP address further includes programming said long lived IP address into the mobile device (col.10, lines 16-32).

5. As per claims 5 & 13 Voit disclosed the method of claim 1 wherein said step of providing a server includes providing a session initiation protocol (SIP) registrar server (col.6, lines 47-63).

6. As per claims 6 & 14 Voit disclosed the method of claim 1 wherein said step of providing a server includes providing a domain name service (DNS) server (col.6, lines 19-42).

7. As per claims 7 & 15 Voit disclosed the method of claim 1 wherein said step of providing a server includes providing wireless application protocol (WAP) server (col.12, lines 6-43).

8. As per claims 8 & 16 Voit disclosed the method of claim 1 wherein said step of assigning a dynamic public address using an application level gateway (ALG) includes using one of a SIP ALG, DNS ALG, and WAP ALG (col.6, lines 14-42).

Response to Arguments

9. Applicant's arguments filed October-28-2004 have been fully considered but they are not persuasive. When prior art is presented to the applicant, it is the responsibility of the applicants to not simply read portions of the prior art but to also gain an understanding of the spirit of the design.

10. As per applicants arguments "the Voit patent does not describe or suggest a target mobile device that is reached through the DNS or any type of NAT, as required by claim 1."

As to applicants arguments Voit on col.6, lines 19-43 describes DNS being used in controlling the routing of calls in a mobile communications system with subscribers who may be roaming on the network. Therefore in essence DNS is reaching the mobile subscriber equipment. Please also refer to figure 4.

11. As per applicants argument "the Voit patent does not describe or suggest any type of private network with a private IP address space, as required by claim 1."

As per applicants arguments the art describes the implementation of this technology in many areas including Corporate Local Area Networks (also known as Intranets or Private Networks), please see col.2, lines 6-9 and figure 5. Also the devices on this LAN will have their own IP addresses.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

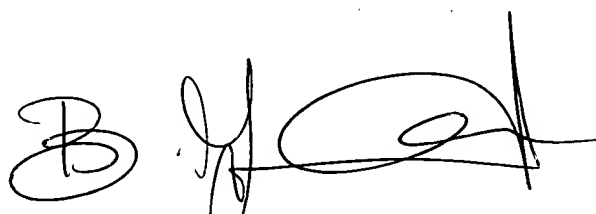
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Asghar Bilgrami
Examiner
Art Unit 2143

AB



BUNJOE JAROENCHONWANT
PRIMARY EXAMINER